

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

9/Election
P. Walker
7-7-03

In re Application of:

MIZUSHIMA

Art Unit: 2863

Examiner: Ngiehm, M. P.

Application No. 09/734,716

Filing Date: November 26, 2001

For: Method and Apparatus for Concurrently Estimating
Respective Directions of a Plurality of Sound
Sources for Monitoring Individual Sound Levels
Of Respective Moving Sound Sources

ELECTION

Assistant Commissioner for Patents
Washington, DC 20231

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Sir:

In response to the restriction requirement dated June 4, 2003, Applicant elects species VI. Claims 18-26, 45, and 46 read on the elected species. Claims 1-3 and 31-33 are generic to the elected species.

Applicant respectfully traverses the restriction requirement and identification of species. In the Office Action, the Examiner has failed to follow the guidelines set forth in the M.P.E.P and the characterization of different species is in error and must be corrected.

As an example of the incorrect reasoning for the Requirement to Elect Species, the Examiner alleges that Figures 1-5B, Figures 11 and 12, and Figures 13-14 are patentably distinct species. However, these three groups of Figures do not describe different species. The invention of Figures 11 and 12 is

directed to the detection of the direction of motion of the sound source. The invention of Figures 13 and 14 is directed to the detection of the speed of motion of the sound source. However, in each case, the estimated sound source direction information is obtained by the invention of Figures 1-5B. Therefore, the invention of Figures 1-5B is not a species akin to the species of Figures 11-12, and Figures 13-14.

Furthermore, the outstanding Requirement for Election of Species has no explanation as to why certain aspects of the invention might be considered to be "independent" and/or "distinct" as is required by M.P.E.P. § 802.01. This is essential for a proper determination as to whether these enumerated "species" are properly subject to separate patentability or not. This was not done. At most, the Examiner has drawn one conclusion and has included standard form paragraphs to go with the assertion that there are nine different species of the invention.

It appears that the Examiner has used the listing of embodiments in the specification as a template for the listing of species. However, the specification itself is not an admission that the disclosed embodiments are patentably distinct species, and the specification cannot be used by the Examiner without more to support the alleged requirement for a species election.

In addition, there has been no showing by the Examiner as to why, or how, the nine listed "species" are somehow patentably "distinct" *from each other*. This would require $n(n-1)/2 = 36$ [n=9] different arguments and statements of comparison between the different enumerated listed "species."

There is not a **single** comparison between **any** of the listed "species" by the Examiner; all that presents itself is the mere statement of "conclusion" that they are patentably "distinct." The Examiner has offered no explanation whatsoever as to why, or how, these particular aspects of the invention were "selected," when other particular aspects of the invention were *not* so selected. However, as the above enumerated regulations show, such a bare "conclusionary" statement without the requisite reasoning is invalid and, by definition, then is arbitrary and capricious.

M.P.E.P. § 803 directs:

"Under the statute an application may be properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - §806.04(i)) or distinct (MPEP § 806.05 - §806.05(i)).

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

....Examiners must provide reasons and/or examples to support conclusions"

Since no such determinations or holdings were done in the Office Action to "support conclusions", it is not seen to meet the requirements of the law as enumerated in M.P.E.P. § 803. Since all the claims at issue in the Office Action depend from generic claims 1 and 31, it is not seen why the second paragraph of M.P.E.P. § 803 should not be invoked. If independent claims 1 and 31 are allowable, why should not all the depending claims also be held allowable? The Office Action provides no rational for the groupings of species; they appear to

be an arbitrary collection, are without the requisite "support conclusions" requirement, and do not appear to be in compliance with the requirements either of the M.P.E.P. or applicable law. The Restriction thus, it is felt, is "improper" under M.P.E.P. § 803.

M.P.E.P. § 806.01 requires:

"In passing upon questions of double patenting and restriction, it is **the claimed subject matter** that is considered and **such claimed subject matter must be compared** in order to determine the question of distinctness or independence."
(Emphasis added)

This is certainly not done in the Office Action; thus there can be no valid determination of "distinctness or independence" since the claims are never analyzed there. Neither is there any discussion of the "claimed subject matter" with regard to "distinctness" in the Office Action. Thus, the restriction requirement would appear to be invalid since the Examiner never made a "distinctness" determination based on a comparison of the "the claimed subject matter," but only a superficial, arbitrary perusal of the drawings. Likewise, the Office Action fails to provide any discussion of "the claimed subject matter," let alone the required "comparison" of "the claimed subject matter," to provide for a valid determination of "distinctness" as is required.

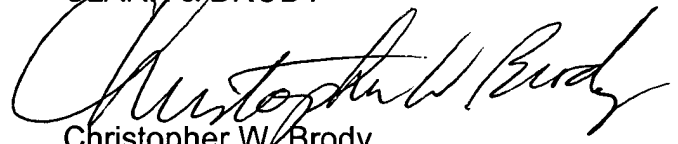
In light of the improper reasoning of the restriction requirement, the Examiner is requested to remake the restriction requirement with the proper grouping of inventions and species so that examination can proceed on the merits for this application.

Furthermore and in light of the identification of generic claims, Applicant also notes that upon allowance of the generic claims, Applicant is entitled to a reasonable number of species, and that at the very least, the species of Figures 11-12, claims 13-15 and 40-42, should be allowed with the elected species.

An early examination on the merits is respectfully requested.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully requested,
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